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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/357,103    07/19/99    VAN DER VOORT

C    082671/0105

HM12/0328

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EXAMINER

GRUNBERG, A

ART UNIT

PAPER NUMBER

1661

6

DATE MAILED:

03/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/357,103

Applicant(s)

Cees A. Van Der Voort

Examiner

Anne Marie Grunberg

Group Art Unit

1661



☒ Responsive to communication(s) filed on Jan 4, 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Requirement for Information

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

**DETAILED ACTION**

The amendment of 10/25/00 has been received and entered. The new declaration of 1/24/01 has been received as well.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant is encouraged to provide a substitute specification under 37 CFR 1.125 because the number and nature of the amendments and the resulting legibility of the application papers renders it difficult to arrange the papers for printing or copying. Applicant is advised of the new procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are mandatory beginning March 1, 2001. Information on the new procedures, as well as other changes to the rules of practice, is available on the Internet at <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>.

***Claim Rejections and Response to Arguments***

1. Claim 1 remains rejected under 35 U.S.C. 112, first and second paragraphs, for the reasons stated in the last office action.

Applicant's amendment dated 1/04/01 failed to address the following objections or raised the following new objections:

A. Applicant needs to define vigor quantitatively. This may be done by describing the length of time until first bloom, or some other indication of the length of time until a certain growth stage or height. By defining it as 20-30% more vigorous than the traditional Stargazer lily, the meaning behind "vigorous" is still unclear.

B. At page 6, line 10, Filaments are said to be white, RHS 145D, however 145D is yellow-green. At page 6, line 14, Applicant describes the stigma as dark pink, however 187A is a very dark purple. Applicant should verify filament and stigma coloration.

***Claim Rejections - 35 USC § 102***

2. The rejection of Claim 1 under 35 U.S.C. 102(d) has been withdrawn.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right NL PBR LEL1147.

Claim 1 is drawn to a lily 'Bernini'.

A lily plant 'Bernini' is described in the referenced web site. Based on the website information, it would appear that 'Bernini' may have been on sale during or prior to 1996, two years before Applicant's earliest priority date. This, in combination with the below described UPOV applications elicits a 102(b). See below for more information.

The claimed lily variety 'Bernini' is described in Breeder's Right NL PBR LEL1147 granted in The Netherlands on 16 May 1995, on an application filed on 5 November 1993. Additional Breeder's Right numbers include BE PBR 25125 filed 22 September 1995; CL PBR 00037 filed 13 November 1995; FR PBR 0158497 filed 4 September 1995; NZ PBR LIL025 filed 15 May 1995; PL PBR LIO0050 filed 4 December 1995; and DE PBR LIU 00079 filed 6 September 1995.

The published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through the Netherlands Board of Plant Breeders' Rights. Notice of Plant Breeder's Right grants is also published in the *Nederlandse Staatscourant*. Plant varieties are also entered in the Netherlands Register of Varieties, which is public. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to

reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the published application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of the Internet revealed a horticultural marketing site indicating that 'Bernini' was on sale more than one year prior to this application. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold, in addition to the above-referenced horticultural site, at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right BE PBR 25125 for the reasons discussed above.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right CL PBR 00037 for the reasons discussed above.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right FR PBR 0158497 for the reasons discussed above.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right NZ PBR LIL025 for the reasons discussed above.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right PL PBR LIO0050 for the reasons discussed above.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right DE PBR LIU 00079 for the reasons discussed above.

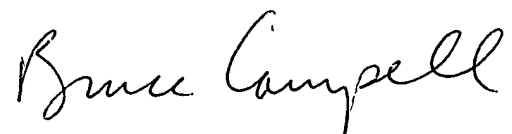
This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

### **Future Correspondence**

Any inquiry concerning this communication from the Examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The Examiner can normally be reached Monday through Thursday from 6:00 am to 3:30 pm and alternate Fridays from 7:00 am to 3:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**BRUCE R. CAMPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**

AMG



## ATTACHMENT

### REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, the claimed plant variety, 'Bernini', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution as well as information pertaining to the date of the licensing agreement. Also, please provide copies of the application, published proposed denomination and published Breeder's Right grant. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the assignee of the instant application is listed by UPOV as applicant, breeder and title holder of the granted Breeder's Right, it is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.



**BRUCE R. CAMPPELL, PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**